REMARKS

The Final Office Action, mailed December 14, 2005, considered and rejected claims 1-21 and 23-30. Claims 24-28 were rejected under 35 U.S.C. 102(e) as being unpatentable by Yap et al (U.S. Patent Publication No. 2002/0040475). Claims 1-12, 16, 18-21, 23, 29-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yap et al in view of Marsh et al (U.S. Patent No. 6,208,799). Claims 13-15 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yap et al in view of Marsh in further view of Vallone et al (U.S. Patent No. 6,642,939). [1]

Initially, although the last action was a final office action, Applicant respectfully submits that this response should be entered after final because it does not introduce any new matter or issues for consideration and because the Final rejection failed to establish a prima facie case of obviousness or anticipation for rejecting the claims.

Claims 1, 18 and 24 are the only independent claims at issue.

As previously discussed, the present invention is directed to embodiments for optimizing storage space through the recording of programming and the management of the recorded programming.

Claim 1, for instance, recites a method for optimizing storage space that includes receiving a user request to record a program. In response to the request, a tag is selectively assigned to the program that is used to control the recording of the program, at least in part. As further recited, the tag includes at least one of a guaranteed tag, an optional tag and a priority tag, each corresponding to different criteria for recording the program. Thereafter, recording rules are applied to the tag to determine whether the request to record will be fulfilled. If so, then the system is automatically programmed to record the program.

Claim 24 is directed to a corresponding recording and management system having means for implementing the foregoing method.

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[1] Although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, inasmuch as it is not necessary following the amendments and remarks made herein, which distinguish the claims from the art of record, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last office action, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicant acquiescing to said assertions or rejections.

The last independent claim, claim 18, recites a method that includes selectively assigning a tag to a recorded program to identify a priority for maintaining the recorded program on the storage device. As further recited, the tag changes after the program is viewed. It is also determined whether the recorded program is a partially recorded program. Then, storage rules are applied to determine whether to delete the recorded program, wherein it is determined to delete the program when the program is partially recorded or when the priority of the first tag changes.

Claim 24 was rejected under §102 as being anticipated by Yap, whereas claims 1 and 18 were rejected for obviousness. In view of these rejections, claim 24 and the anticipation rejections will be addressed first.

Before addressing the merits of the rejection to claim 24, Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102 (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. *See* Manual of Patent Examining Procedure ("M.P.E.P.") § 2131.

In view of the anticipation rejection requirements, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of anticipation because Yap fails to contain each and every element as set forth in the claims (expressly or inherently) in as complete detail as contained in the claim. For example, Yap fails to teach, among other things, (1) that after a request is received by a viewer to record a program that a tag is selectively assigned to the program to control recording of the program, wherein the tag is one of a guaranteed tag, an optional tag or a priority tag, each corresponding to different criteria for recording the program, or that (2) recording rules are applied to the tag to determine whether the request to record the program is to be fulfilled, as recited in combination with the other recited claim elements.

In fact, in rejecting a different claim (claim 1), the Examiner actually acknowledges that Yap "fails to disclose the first tag is used by the system to control, at least in part, recording of said first program, said first tag including at least one of a guaranteed tag, an optional tag or a priority tag, each of the guaranteed, optional and priority tags corresponding to different criteria for recording said program." In view of this acknowledgement, claim 24 cannot be found to be anticipated by Yap because claim 24 requires this element that is admittedly not found in Yap.

In rejecting claim 24, the Examiner cites to Figure 3, step 310, as apparently corresponding to the foregoing claim element for selectively assigning a tag to control recording, comprising one or more of a guaranteed tag, optional tag and priority tag. However, this disclosure fails to teach or suggest that any tag is ever assigned upon receiving a recording request, as required. Instead, this disclosure only teaches how to search for programs by referencing tags that describe the content that is found within the corresponding programs.

Yap also clearly fails to disclose or suggest that recording rules are applied to the tags to determine whether the request to record is to be fulfilled. The Examiner refers to Figure 3, step 340 as purportedly teaching this element. However, this disclosure merely corresponds to a decision 'whether the consumer wants to add tracked information to a program selection.' (¶ [118]). The information that can be added is content and selection criteria that was previously selected by the viewer. (¶[117]). The cited disclosure fails to address the application of any recording rules to tags that control recording, comprising one or more of a guaranteed tag, optional tag and priority tag, which are selectively assigned after receiving a recording request.

For at least the foregoing reasons, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of anticipation for rejecting claim 24 and such that the rejections to claim 24 should be withdrawn.

Claim 1, was rejected for obviousness in view of Yap and a newly cited reference Marsh. Applicants respectfully submit, however, that the combination of Yap and Marsh fail to render claim 1 obvious. In particular, Yap and Marsh fail to disclose or suggest, among other things, that after a request is received by a viewer to record a program that a tag is selectively assigned to the program to control recording of the program, wherein the tag is one of a guaranteed tag, an optional tag or a priority tag, each corresponding to different criteria for recording the program.

In fact, as mentioned above, the Examiner acknowledges that Yap "fails to disclose the first tag is used by the system to control, at least in part, recording of said first program, said first tag including at least one of a guaranteed tag, an optional tag or a priority tag, each of the guaranteed, optional and priority tags corresponding to different criteria for recording said program."

To compensate for the failings of Yap, the Examiner has relied on Marsh. It is unclear, however, what disclosure in Marsh the Examiner is relying on. The Examiner cites to Col. 2,

lines 5 F. However, Col. 2 fails to make any mention of the referenced priorities described by the Examiner.

While Marsh is generally directed to methods for recording program-delayed events and for accommodating changes in IPG data to adjust or change the recording schedule[2], Marsh fails to disclose or suggest that after a request is received by a viewer to record a program that a tag is selectively assigned to the program to control recording of the program, wherein the tag is one of a guaranteed tag, an optional tag or a priority tag, each corresponding to different criteria for recording the program, as required by the claims.

Marsh does talk about resolving conflicts in columns 7 and 10. However, even these passages fail to disclose that a tag is selectively assigned to a program to control recording of the program, wherein the tag is one of a guaranteed tag, an optional tag or a priority tag, each corresponding to different criteria for recording the program. The Examiner suggests that Marsh teaches of guarantee type recordings. However, based on our reading of Marsh it only appears that a recording is guaranteed if there are no conflicts, by default, or that if a conflict arises, either the user cancels a prior recording instruction, aborts the recording, or a recording that is furthest out in time will be deleted. (Col. 7, ll. 9-33 and Col. 10, ll. 19-34).

For at least the foregoing reasons, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness for rejecting claim 1 and such that the rejections to claim 1 should be withdrawn.

The last independent claim 18 was also rejected for obviousness. However, it is not entirely clear what the rejection to claim 18 is. The reason for this is because the Office Action states on page 5 that claim 18 is being rejected in view of a combination of Yap and Marsh. However, in the detailed description of the rejection, Vallone is the only art referenced in the rejection.

In view of the detailed description of the rejection to claim 18, found on pages 11 and 12, Applicant respectfully submits that Vallone fails to teach or suggest the claimed invention. For example, among other things Vallone fails to teach or suggest (1) that a tag is selectively assigned to a recorded program to identify priorities for maintaining the recording and wherein **the priority changes after the recorded program is viewed.**

[2] Col. 3, ll. 20-23 and 52-59.

With regard to the element for assigning a tag in which the priority "changes after the first recorded program is viewed on the system", the Examiner refers to Figure 17, element 1704 and the description in Col. 15, ll. 33-67 and Col. 16, ll. 1-50. This disclosure, however, merely refers to a UI graphical indication (yellow dot) that indicates that a program will be deleted within a shorter time than about 24 hours. (Col. 15, ll. 59-63). There is nothing to suggest that the priority of an assigned tag changes after a program is watched.

As previously discussed, Vallone also fails to disclose or suggest, among other things, that a tag assigned to a program is changed after the program is recorded or that a determination is made whether a program is only partially recorded, as claimed. Vallone also fails to disclose or suggest a method in which it is determined that a recorded program should be deleted when the program is only partially recorded or when the priority of the first tag changes. The Examiner has referenced Col. 15, ll. 60-67. However, this disclosure merely indicates that different UI icons can reflect to the user which programs are going to be deleted.

In view of the foregoing, the rejections of record are now moot, such that it is not necessary to address each of the other assertions of record in the last response. Nevertheless, Applicants reserve the right to challenge any of said assertions in the future. Accordingly, although the foregoing remarks are primarily directed to the independent claims, it will be appreciated that the dependent claims should also be found allowable over the art of record for at least the same reasons. Accordingly, it is not necessary to individually address the rejections to each of the dependent claims at this time. Nevertheless, a few of the dependent claims will be addressed by the following remarks, as discussed during the interview, to even further distinguish the claimed invention over the art of record.

For example, the cited art also clearly fails to disclose or suggest methods, such as recited in claim 5, wherein the guaranteed tag causes space to be reserved in the recording medium at the time the request to record is made, as opposed to a time at which the program is broadcast. The Examiner cites to paragraphs 116-118 and step 320. However, this disclosure does not talk about reserving space at all and step 320 corresponds to allowing "the user to manually input selection criteria."

As yet another non-limiting example, the cited art fails to address any embodiment in which a bucket defining a limit of recording is established, such as for an episode or repeating show, and wherein upon determining the bucket size is exceeded that a program is recorded, as

recited in claim 23. In rejecting this claim the Examiner fails to even address the recited claim elements. (see pages 13-14 of the Office Action).

In rejecting claim 30, the Examiner also fails to provide any rationale or support for the assertion that Yap teaches the claimed use of the priority, optional and guarantee tags. (see page 14).

For at least the foregoing reasons, Applicants respectfully submit that all of the rejections of record are moot and that the pending claims 1-21 and 23-29 are in condition for prompt allowance.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 14 day of March, 2006.

Respectfully submitted,

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